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08/976,159	11/21/1997	NEIL FREDERICK BRANDER	2656/2	1527
26646	7590	08/18/2008		EXAMINER
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				JEANTY, ROMAIN
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NEIL FREDERICK BRANDER
and
ANDREW JOHN ZELENKA

Application 08/976,159
Technology Center 3623

Mailed: August 18, 2008

Before DALE M. SHAW *Chief Appeals Administrator*.
SHAW, *Chief Appeals Administrator*.

This application was received electronically at the Board of Patent Appeals and Interferences on March 19, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the

examiner. The matter requiring attention prior to docketing is identified below:

An examination of the Image File Wrapper (IFW) reveals that an Order Returning Undocketed Appeal was mailed on August 29, 2007 which listed the following deficiencies and requested that the Examiner:

1. locate a copy of the missing June 19, 2003 Order Returning Undocketed Appeal and have a complete copy scanned into the IFW; and
2. determine the status of claims 14-17, 19 and 20.

In response, a copy of the June 19, 2003 Order Returning Undocketed Appeal was furnished on February 21, 2008. In addition, claims 14-17, 19 and 20 have now been included in the following rejection appearing on page 3 of the Examiner's Answer mailed October 25, 2006:

Claims 1-9, 12-17, 19-36 are rejected under 35 U.S.C. 103(a) As being unpatentable over The Depository Trust Company (Herein referred to "DTC") in view of Hawkins et al. (US 5,497,317).

However, it should be noted that page 7 of the Non-Final Rejection mailed August 19, 2002 lists the rejection of claims 14-17, 19 and 20 as follows (which agrees with page 4 of the Appeal Brief filed November 25, 2002):

Claims 14-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over DTC in view of Lupien (6,098,051).

It appears that the inclusion of claims 14-17, 19 and 20 under 35 U.S.C. 103(a) in the Examiner's Answer mailed October 25, 2006, as being unpatentable over DTC in view of Hawkins et al (US 5,497,317) would be a new ground of rejection¹ since claims 14-17, 19 and 20 were only rejected under DTC and Lupien in the Non-Final Rejection mailed August 19, 2002.

37 CFR § 41.39 (2006) states:

§ 41.39 Examiner's answer.

(a)(1) The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief including such explanation of the invention claimed and of the references relied upon and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner determines that the appeal does not comply with the provisions of §§ 41.31 and 41.37 or does not relate to an appealable action, the primary examiner shall make such determination of record.

(2) An examiner's answer may include a new ground of rejection.

(b) If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

¹ It is noted that the discussion of claim 14 appearing on page 8 of the Examiner's Answer mailed October 25, 2006 makes reference to the Lupien reference.

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

In order to include a new ground of rejection in the Examiner's Answer, the examiner must follow the guidelines set forth in training material entitled "Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule," located at the following URL:

www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html

The requirements for a new ground of rejection are:

- 1) Approval by a Technology Center Director or designee;² and
- 2) Prominently identified, by a separate heading with all capital letters

in the following sections of the Examiner's Answer:

 Grounds of Rejection to be Reviewed on Appeal section, and

 Grounds of Rejection section.

To correct this problem, the examiner will need to vacate the Examiner's Answer mailed October 25, 2006. Once the Examiner's Answer mailed October 25, 2006 is vacated, the examiner has the following options:

- 1) to write a new Examiner's Answer without the new grounds of rejection;
- 2) to reopen prosecution; or
- 3) to write a new Examiner's Answer properly setting forth the new grounds of rejection.

² Technology Center 3600 only allows approval by a Director.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to vacate the Examiner's Answer mailed October 25, 2006;
- 2) to select one of the following options:
 - a) reopen prosecution;
 - b) write a new Examiner's Answer³ without the new grounds of rejection; or
 - c) write a new Examiner's Answer properly setting forth the new grounds of rejection; and
- 3) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

DMS:psb

Kenyon & Kenyon LLP
One Broadway
New York, NY 10004

³ It is also noted that page 1 of the Examiner's Answers mailed October 25, 2006, March 13, 2006, January 23, 2003 and October 25, 2006 states that the Answer "is in response to Appellant's brief on appeal filed 07/09/2001." It appears that this date is incorrect since the Final Rejection was mailed on October 29, 2001 and the Notice of Appeal filed on February 19, 2002. This date should be corrected on any future Examiner's Answers.